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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,637	01/23/2002	Stephen L. Siegler	LAWR0021US	9426

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LEVINE & MANDELBAUM
350 FIFTH AVENUE SUITE 7814
EMPIRE STATE BUILDING
NEW YORK, NY 10118

EXAMINER

FLANDRO, RYAN M

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 12/26/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/055,637

Applicant(s)

SIEGLER ET AL.

Examiner

Ryan M Flandro

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. If applicant desires priority under 35 U.S.C. 120 based upon a previously filed copending application, specific reference to the earlier filed application must be made in the instant application. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. _____" should follow the filing date of the parent application.

Specification

2. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. **Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading.** If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.

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(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(f) BRIEF SUMMARY OF THE INVENTION.

(g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(h) DETAILED DESCRIPTION OF THE INVENTION.

(i) CLAIM OR CLAIMS (commencing on a separate sheet).

(j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

3. The abstract of the disclosure is objected to because (1) it is too long, and (2) it refers to tension-retaining "means" in lines 13 and 15. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of **50 to 150 words**. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. **The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided.** The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Objections

4. Claims 1-6, and 8 are objected to because of the following informalities:

a. Claim 1. A comma should be added after the word "hollow" in line 2 of the claim for purposes of clarity and grammar. The Examiner has assumed that the word "hollow" is meant to be a modifier of the subsequently mentioned "post."

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- b. Claims 2-6, and 8. The word “A” at the beginning of each claim should be changed to “The”.
- c. Claim 5. The word “the” should be inserted between the words “of” and “slot” in line 3 of the claim for grammatical purposes.
- d. Claim 8. The word “based” in line 2 of the claim should be changed to “biased”.
- e. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Claim 2. Claim 2 recites the limitations “the outer diameter of the cassette” and “the internal diameter of the post” in lines 2 and 3, respectively. There is insufficient antecedent basis for this limitation in the claim because the cassette and the post are not previously claimed as being circular or cylindrical in shape and such diameters are not previously recited in the claim or in claim 1 from which claim 2 depends.
- b. Claim 4 recites the limitation “means for supporting the cassette” in line 2 of the claim. This renders the claim indefinite because it is unclear whether the “means for supporting” is the same as, or different from, the “means for holding the cassette” recited in the last line of claim 1 from which claim 4 depends.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, are rejected under 35 U.S.C. 102(b) as being anticipated by Oster (US 4,844,420).

a. Claim 1. Oster specifically discloses a pedestrian traffic control device **10** comprising a hollow[,] upright, one piece, post **22,12** having an open upper end and a lower end; at least one slot **24** in the post **22,12** between its ends, the slot **24** being spaced from both ends of the post **22,12**; a cassette **52** located within the post **22,12** and between its ends, the cassette **52** incorporating a tape **18** wound on a spool **30**, the tape **18** being extendable from the cassette **52**, through the slot **24** in the post **22,12**, in a direction generally perpendicular to the axis of the post **22,12**; and means **32,34,36,22,22a** for holding the cassette **52** within the post **22,12**. (See Figures 1, 2, and 4; column 1 line 62 – column 2 line 64.)

b. Claim 2. Oster further discloses that the outer diameter of the cassette **52**, along its entire axial length, is smaller than the internal diameter of the post **22,12**, so that the cassette **52** can be inserted into the open upper end of the post **22,12** and moved to its location between the ends of the post **22,12** (see figure 4).

- c. Claim 4. Oster further discloses means **32,34,36,22,22a** for supporting [holding?] the cassette **52** within the post **22,12** in the region of the slot **24** in the post **22,12** (see figures 2, 2A, and 4; column 1 line 62 – column 2 line 64).
- d. Claim 5. Oster discloses the support means **32,34,36,22,22a** includes a tube **22,22a** within the post **22,12** having an upper end in the region of the lower end of [the] slot **24** in the post **22,12**, the cassette **52** being seated upon the upper end of the tube **22,22a** (see figures 2, 2A, and 4).
- e. Claim 7. Oster also shows a method of assembling a pedestrian traffic control device **10**, the device **10** including a hollow post **22,12** having an open upper end and a slot **24** between and spaced from the post **22,12** ends, and a cassette **52** incorporating a spool **30** on which a tape **18** is completely wound, the free end of the tape **18** being exposed, the method including the steps of: inserting the cassette **52** into the open end of the post **22,12**, maneuvering the cassette **52** along the length of the post **22,12** until the free end of the tape **18** is accessible through the slot **24** in the post **22,12**; pulling the free end of the tape **18** through the slot **24**; and attaching a finger pull **20** to the free end of the tape **18** exposed outside the post **22,12**, the pull **20** being sized large enough so that the free end of the tape **18**, with pull **20** attached, cannot be retracted into the post **22,12** through the slot **24** (see figure 4).
- f. Claim 8. Oster lastly discloses that the tape-carrying spool **30** is spring [biased] in a direction tending to wind the tape **18** on the spool **30**, so that pulling the free end of the tape **18** through the post slot **24** adds tension to the spring **28** (figure 4; column 2 lines 45-48).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oster, as applied to claim 1 above.

a. Claims 3. Oster discloses all of the limitations recited in claim 3 except for the lower edge of the tape, when extended, being less than twenty-seven (27) inches above the floor supporting the post. It would have been obvious, however, to one having ordinary skill in the art at the time the invention was made to move the cassette of Oster from the upper end of the post to another position wherein the lower edge of the tape is less than 27 inches above the floor since it has been held that rearranging parts of an invention

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involves only routine skill in the art. *In re Japikse*, 86 USPQ 70 (CCPA 1950) (holding that claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device). Likewise, positioning the tape at 27 inches above the floor would have been obvious since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 205 USPQ 215 (CCPA 1980).

b. Claim 6. Oster discloses all of the limitations recited in claim 6 except for the pedestrian control device explicitly having no tape-holding cassette occupying the upper end of the post. It would have been obvious, however, to one having ordinary skill in the art at the time the invention was made to move the cassette of Oster from the upper end of the post to another position since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70, (CCPA 1950).

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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13. Claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 5, 12, and 13, respectively, of U.S. Patent No. 6,375,164 ('164 patent).

a. Claims 1, 2, and 4-8. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the '164 patent disclose each and every limitation set forth in claims 1, 2, and 4-8.

b. Claim 3. Again, although the conflicting claims are not identical, they are not patentably distinguishable from each other because claim 1 of the '164 patent recites the general limitations of claim 3 of the instant application. Claim 3 recites the limitation that the lower edge of the tape be less than 27 inches above the floor. It has been held, however, that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 205 U.S.P.Q. 215 (C.C.P.A. 1980).

Conclusion

14. The Examiner has considered the prior art cited in the earlier application (09/335,572 6/18/1999 PAT 6,375,164). MPEP § 2001.06(b).

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the state of the art with respect to pedestrian traffic control devices:

U.S. Patent 6,142,701 to Falcon

U.S. Patent 5,816,946 to Grossman

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U.S. Patent 5,050,846 to Goodman et al.

U.S. Patent 4,124,196 to Hipkind

U.S. Patent 4,119,301 to Payne

U.S. Design Patent D447,251 S to Tsai

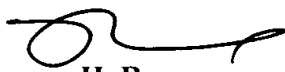
U.S. Design Patent D343,690 to Carey

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan M Flandro whose telephone number is (703) 305-6952. The examiner can normally be reached on 8:30am - 5:30pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H Browne can be reached on (703) 308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Ryan M. Flandro
December 16, 2002


Lynne H. Browne
Supervisory Patent Examiner
Technology Center 3670